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VIA ELECTRONIC FILING AND HAND DELIVERY

The Honorable Judge Leonard P. Stark
J. Caleb Boggs Federal Building
844 N. King Street, Unit 26, Room 6124
Wilmington, DE 19801-3556

**REDACTED
PUBLIC VERSION**

Re: Xerox Corp. v. Google, Inc., et al., C.A. No. 10-136-LPS

Dear Judge Stark:

Plaintiff Xerox Corporation ("Xerox") respectfully requests that this Court order Defendants Google Inc., Yahoo! Inc. and Right Media LLC ("Defendants") to supplement their invalidity contentions to provide essential information they have refused to disclose, specifically: (1) to identify and provide a separate claim chart for each prior art reference Defendants contend anticipates a claim of the '979 Patent and for each combination of references Defendants contend renders a claim obvious; (2) in each claim chart, to identify where each claim limitation is allegedly found in a reference; (3) for each combination of prior art references alleged to render a particular patent claim obvious, to explain why a person of ordinary skill would have thought to combine the teachings of those references in the manner found in that patent claim; and (4) to provide contentions for every defense Defendants intend to rely upon at trial.

On April 23, 2010, Xerox served Defendants with invalidity contention interrogatories. (Ex. 1 at 10-11.) After objections and foot dragging, Defendants responded in July 2010 with a laundry list of purported prior art devoid of any claim charts or explanations. In addition, Defendants revealed no bases for their asserted defenses under 35 U.S.C. §§ 101 and 112. Xerox then repeatedly sought supplementation, without success. (*See, e.g.*, Ex. 2 at 2; Ex. 3 at 2.)

In February 2011, Defendants sought to compel Xerox to provide more detailed infringement contentions. In particular, Defendants demanded identification of where every claim limitation (for example, the "categories" and "labels" of the "automatically categorizing" step of Claims 1 and 18) was found in each accused product (*see, e.g.*, Ex. 4 at 1-2; Ex. 5 at 2), notwithstanding that Xerox had actually provided such information. Less than a day before Xerox's responsive letter brief was due, Defendants served Xerox with invalidity claim charts collectively comprising 284 pages. During the subsequent Court call, Defendants represented that they had provided "a detailed explication of invalidity contentions". (Ex. 6 at 8:1-3.)

Upon examining Defendants' contentions, however, Xerox discovered that Defendants had essentially provided 26 versions of the same claim chart. Each chart listed citations to up to 14 references—the same citations, to the same 14 references, in every chart. The only reason the charts appear different is because each chart contains block quotes from a different one of the 14

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references. (See Ex. 7.) Defendants provided no claim charts at all for 24 asserted references, no information concerning where discrete claim limitations (“categories”, “labels”, etc.) are purportedly found in any reference, no indication whether they contend that any particular reference anticipates any claim, no alleged reason to combine any set of references to render any individual claim obvious, and no basis for their purported defenses under §§ 101, 103 and 112.

In March and April, Xerox repeatedly raised these problems with Defendants, only to be met with more foot-dragging. (See Exs. 8-15.) On April 15, Defendants finally served supplemental contentions that left the vast majority of prior deficiencies unaddressed, including the deficiencies in the claim charts for Claims 1 and 18. When Xerox again asked Defendants to correct these problems, Defendants refused. (See Exs. 16-18.) Then, remarkably, Defendants served Xerox with interrogatories seeking detailed contentions rebutting the invalidity contentions that they have refused to substantiate. (See Ex. 19 at 6-8.) Defendants’ tactic of hiding the ball while asking Xerox to prove a negative should not be tolerated. Xerox respectfully requests that the Court order Defendants to remedy each of the deficiencies below.¹

1. Failure to provide proper claim charts for all references: (a) Defendants have failed to provide any claim charts at all for 27 of the references cited in their contentions. As for the rest, despite their seemingly voluminous charts, Defendants have not provided (b) a single anticipation chart, or (c) a single obviousness chart. Instead, Defendants vaguely assert that each of 17 references might either anticipate or else be part of a hazy kaleidoscope of references that render the claim obvious. Xerox respectfully requests that the Court compel Defendants to provide an anticipation or obviousness chart for each reference upon penalty of being precluded from relying on any reference for which an adequate claim chart is not provided.

2. Failure to identify where any claim limitations are found in any reference: None of Defendants’ charts identifies where any discrete claim limitation (e.g., “organized classification of document content”, “class”, “classification label”, etc.) is found in any prior art reference. Instead, Defendants simply provide block quotes from various references and leave Xerox to guess where those claim limitations are purportedly found. For example, each Defendant contends that the following quote from the Ford reference discloses the first step of Claim 1:

’979 Patent Language	Ford Reference
“defining an organized classification of document content with each class in the organized classification of document content having associated therewith a classification label; each classification label corresponding to a category of information in an information retrieval system;”	“As shown in FIG. 3, this aspect of the present invention [i.e., serving contextually-relevant advertisements] will extract and analyze the summary information generated by LISA 50 and then respond with an appropriate message or advertisement responsive to the subject matter of the summary information. Specifically, based upon the user’s specifications, the present invention will look for the temporally contiguous occurrence of a particular keyword or set of keywords. The appearance of such keywords would be used to infer the general topic or subject matter of the communication or conversation. Once the general subject area of the conversation has been (probabilistically) deduced, the present invention may be used to present advertisements in the chat room that match the theme of the conversation.” 11:4-17.”

¹ Yesterday, Defendants served fourth sets of supplemental invalidity contentions on Xerox. These newest sets of contentions simply add another inadequate claim chart for a newly asserted prior art reference (along with citations to that reference throughout all other claim charts) and a single conclusory paragraph concerning § 101 defenses, but do not remedy any of the deficiencies enumerated below.

(Ex. 20, Chart B-9, at 2; Ex. 21, App. C, at 2.) But it is impossible to discern what purportedly comprises an “organized classification of document content”, a “class” therein, a “classification label”, the “information retrieval system” and the “categor[ies] of information in [the] information retrieval system”. Indeed, since this quote is paired with cross-references to 14 other prior art references, it is not clear whether Defendants are even contending that the Ford reference discloses each and every limitation of this claim step, let alone of the entire claim. Defendants’ refusal to identify individual claim limitations is particularly egregious given their prior demands for the same information in Xerox’s infringement contentions. (*See, e.g.*, Ex. 4 at 2 (“Xerox fails to identify the ‘categories’ and ‘labels’ it contends Google utilizes.”); Ex. 5 at 2 (“Rather than identifying where each limitation could be found in each product, however, Xerox simply repeated the claim language.”).) In contrast to Defendants’ unexplained quotations, Xerox’s infringement contentions disclose in detail where each limitation of each step of each asserted claim is found in Defendants’ products. (*See, e.g.*, Ex. 22, App. A, at 4-20 and Ex. 23, App. A, at 4-11 (“organized classification of document content”).) Defendants contentions should be no less specific. Xerox respectfully requests that the Court order Defendants to identify where each discrete claim limitation is allegedly found in every reference, upon penalty of being precluded from relying on any reference for which they do not provide this information.

3. Failure to provide adequate obviousness contentions: “[A] defendant asserting obviousness in view of a combination of references has the burden to show, by clear and convincing evidence, that a person of ordinary skill in the relevant field had a reason to combine the elements in the manner claimed.” *Alcon, Inc. v. Teva Pharms. USA, Inc.*, 664 F. Supp. 2d 443, 460 (D. Del. 2009) (citing *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 421-22 (2007)). Defendants’ invalidity contentions fail to disclose which particular combinations of references Defendants intend to rely upon, and provide no reason why persons of ordinary skill would have been motivated to combine a particular references in 2001, when Xerox filed for the ’979 Patent. Indeed, since Defendants repeatedly assert that “[t]o the extent this reference does not teach this claim element, this reference in combination with the knowledge of one of ordinary skill in the art renders this claim element obvious”, Xerox cannot even tell whether they are asserting anticipation or obviousness with respect to any given reference. (*See, e.g.*, Ex. 20, Chart B-9, at 2; Ex. 21, App. C, at 2.) In lieu of this basic detail, Defendants have merely included a generalized narrative, separate from their claim charts and not discussing any purported references, based solely on mischaracterizations of inventor testimony. (*See* Ex. 20 at 20-26; Ex. 21 at 11-13.) Xerox respectfully requests that Defendants be ordered to provide detailed contentions for each discrete combination of prior art they allege renders obvious an asserted claim, along with reasons a person of ordinary skill would have thought to make that particular combination in 2001, upon penalty of being precluded from relying on that combination.

4. Contentions for every invalidity defense: Although Defendants pleaded affirmative defenses arising under 35 U.S.C. §§ 101 and 112, they have been dilatory in substantiating these defenses. Defendants waited until April to serve § 112 contentions, and did not serve any § 101 contentions until the day before Xerox’s letter brief was due. At this point, 15 months into the case, there is no excuse for further delay. Xerox respectfully requests that Defendants be ordered to submit detailed contentions now for any defenses they intend to rely on, upon penalty of being precluded from relying on defenses for which they do not provide such contentions.

For the foregoing reasons, Xerox respectfully asks the Court to grant the requested relief.

Respectfully,

/s/ Lauren E. Maguire

Lauren E. Maguire

Attachments

cc: Richard L. Horwitz, Esquire (hand delivery; w/attachments)
David A. Perlson, Esquire (via electronic mail; w/attachments)
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